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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.       |
|---|-------------|----------------------|---------------------------------|------------------------|
| 10/520,244  | 09/02/2005  | Mark Diener          | 231945                          | 2528                   |
| 23460 7590 06/07/2007<br>LEYDIG VOIT & MAYER, LTD<br>TWO PRUDENTIAL PLAZA, SUITE 4900<br>180 NORTH STETSON AVENUE<br>CHICAGO, IL 60601-6731 |             |                      | EXAMINER<br>PETERSON, KENNETH E |                        |
|   |             |                      | ART UNIT<br>3724                | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>06/07/2007         | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/520,244   | <b>Applicant(s)</b><br>DIENER, MARK |  |
|                              | <b>Examiner</b><br>Kenneth E. Peterson | <b>Art Unit</b><br>3724             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 20-56 is/are pending in the application.
- 4a) Of the above claim(s) 21-29, 32-36 and 39-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20, 30, 31, 37 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>30 May 06, 07 April 06</u> . | 6) <input type="checkbox"/> Other: _____  |

1. Applicant's election with traverse of group II, species A in the reply filed on 18 May 07 is acknowledged. The traversal is on the ground(s) that that it would not be an undue burden to examine multiple groups. This argument is found to be partially persuasive. During the search for group II, Examiner determined that it would not be a serious burden to also search for groups V and VI. Accordingly, groups V and VI are hereby rejoined.

With the rejoinder, claims 20,30,31,37-39,48,49,55 and 56 are in the elected group. Applicant's election of Species A was not accompanied by an indication of which elected claims read on the elected species. Examiner has determined that elected claims 20,30,31,37 and 38 read on the elected species. Claims 39,48,49,55 and 56 read exclusively on a different species. Accordingly, claims 21-29,32-36,39-56 are hereby withdrawn from consideration.

The requirement, as modified, is still deemed proper and is therefore made FINAL.

2. Claims 30 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 30 and 31 recite "two vertical arms", "a parallel guide" and two "linear guide". It is not clear if these are all the same thing, namely elements 27 and 28, or different elements. The specification mentions rails 31, but both the arms and rails could be considered "guides". Furthermore, paragraph 0036 indicates that the vertical

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arms are the parallel guide, so they should not be claimed as if they were a separate element.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 20,30,31,37 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by EP0722814 to Schultz et al., who shows a band saw with all of the recited limitations including;

A support device (6),

A machine frame (11,floor),

A main carrier (13),

A swivel support (D) having a driving device (14 or 16),

An intermediate carrier (15) having two vertical arms (9) with linear guides,

A saw frame (8) having two rollers.


5. Made of record but not applied is a reference to Epple showing a pertinent beveling band saw.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth E. Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Mon-Thur, 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

kp

  
KENNETH E. PETERSON  
PRIMARY EXAMINER